

## REMARKS

This is in response to the Office Action mailed on April 10, 2003 for the above-captioned application. Reconsideration of the application, as amended, and allowance of all claims in view of the remarks herein, are respectfully requested.

The **first** issue is whether the Examiner is justified in rejecting claim 196 on the grounds that a data stream is non-statutory subject matter because the data therein does not impact functionality to the data stream, regardless of the content of the data stream.

10 In the Office Action at page 2, claim 196 is rejected under 35 USC 101 as directed to non-statutory subject matter because "... the data does not impact functionality to the data stream as claimed."

Applicant respectfully directs the Examiner's attention to the Manual of Patent Examining Procedure at Section 2106(c), which provides in relevant part "However, a signal claim directed to a practical application of electromagnetic energy is statutory regardless of its transitory nature." [Citations omitted.]

Additionally, Applicant respectfully notes that Section 101 does not contain any requirement that an invention "impact functionality" to anything.

Furthermore, Applicant asserts that the limitations contained in claim 196 do impart functionality to the data stream as claimed.

20 In light of the foregoing discussion, Applicant respectfully requests that claim 196 be allowed.

The **second** issue is whether the Examiner is justified in rejecting claims 169-171, 173-177, 179, 182-183, and 184-208 under 35 U.S.C. 101 on the grounds that they are non-statutory.

In the Office Action at page 2, the Examiner rejects claims 169-171, 173-177, 179, 182-183, and 184-208 under 35 U.S.C. 101.

30 Applicant has amended each of claims 169, 173, 179, 182, 184, 185, 187, 191, 197, 203 and 204 to recite that the system "includes without limitation a computer apparatus".

In light of the foregoing discussion, Applicant respectfully requests that claims 169-171, 173-177, 179, 182-183, and 184-208 be allowed.

The **third** issue is whether the Examiner is justified in rejecting claims 177 and 178 under 35 USC 112.

In the Office Action at page 3, paragraph 4, the Examiner asserts that "[i]t is confusing as to if the digital signature is claimed or not."

Claim 177, step (c), requires "sending ... a reply that: (1) comprises ... a digital signature ... and (2) is sent ... in a manner that is secured without relying upon the digital signature..." Clearly, the text of Claim 177 requires both that the reply comprise a digital signature and that the reply also be secured in a manner that does not rely upon the digital signature.

Claim 178, item (c), requires a "means for securely sending a reply ... where the reply: (1) comprises ... a digital signature ... and (2) is sent ... in a manner that is secured without relying upon the digital signature." Clearly, the text of Claim 178 requires both that the reply comprise a digital signature and that the reply also be secured in a manner that does not rely upon the digital signature.

For example, a reply that includes a digital signature (see for example the discussion in the application at page 29 line 25 - page 30 line 8) could also be encrypted using a method that is completely independent of the digital signature and treats the digital signature simply as part of the plain text that is being encrypted.

While it might be unusual both to digitally sign a reply and to secure the same reply in a second manner that does not rely upon the digital signature, novelty is normally considered desirable in a patent claim.

In light of the foregoing discussion, Applicant respectfully requests that claims 177 and 178 be allowed.

The **fourth** issue is whether Adams et al. (3,573,747 hereinafter Adams) suffices to justify rejection of claims 169-176 despite: (a) Adams's failure to disclose (a-1) sending or receiving a request that includes an identifier associated with an offer, (a-2) sending or receiving a request in a manner that does not imply that the request is from a

person entitled to receive nonpublic information concerning the offer, and (a-3) in response to such a request, sending a reply that comprises a data item that concerns the offer; and (b) Adams's teaching away from (b-1) using a query/response protocol to communicate information about a particular offer and (b-2) communicating about offers in a manner that does not imply that such communication is from or to a person entitled to receive nonpublic information about such offer.

Claims 169-176 are rejected under 35 USC 102(b) for the first time as being anticipated by Adams.

10 (a) Adams fails to disclose elements of claims 169-176, including elements which the Examiner asserts Adams does disclose.

(a-1) Adams fails to disclose sending or receiving a request that includes an identifier associated with an offer. In the Office Action at page 4, the Examiner asserts that Adams, at column 10 lines 1-15 and column 12 lines 1-9, teaches "receiving request for information where the request includes the first identifier". However, Applicant has carefully read the portions of Adams cited by the Examiner and has been unable to locate any disclosure therein concerning a request that includes an identifier associated with an offer.

20 In reviewing the portions of Adams cited by the Examiner, it is important to note that when Adams speaks of a "Reply", he is speaking of a counter-offer that is entered into an offer matching system by a subscriber to that system. Adams is not speaking of a reply by an offer matching system to a request for information that includes an identifier associated with an offer. Consequently, Adams's specialized use of the term "Reply" should not be understood to imply any sort of underlying request to an offer matching system.

30 When Adams speaks at column 10 lines 1-12 of subscriber B's "Reply" to subscriber A's "Book & Broadcast", Adams means subscriber B's counter-offer to subscriber A's original offer. This is summarized in Adams at column 10 lines 16-19 which explains that after keying in "REPLY" and "20562" (the identifier associated with Subscriber A's original offer), "[n]ext subscriber A strikes key 172 in the BUY shift thus indicating that his reply is an offer to buy securities of X Corporation and is in response to an offer of subscriber A to sell said securities." For a painfully detailed

description of how the offer matching system of Adams processes "Book & Broadcast" commands, see Adams at column 15 line 69 - column 19 line 72. For a painfully detailed description of how the offer matching system of Adams processes "Reply" to an offer commands, see Adams at column 26 line 1 - column 27 line 63.

Similarly, when Adams speaks at column 12 lines 7-8 of "Replies" from subscribers, Adams means counter-offers (entered using "Reply" to an offer commands, see Adams at column 26 line 1 - column 27 line 63, or "Reply" to a Reply commands, see Adams at column 27 line 64 - column 29 line 69) to previously entered offers (entered with "Book" or "Book and Broadcast" commands, see Adams at column 15 line 69 - column 19 line 72) or to previously entered counter-offers (entered with "Reply" commands or "Reply" to a Reply commands).

(a-2) Adams fails to disclose sending or receiving a request in a manner that does not imply that the request is from a person entitled to receive nonpublic information concerning the offer. In the Office Action at page 4, the Examiner asserts that Adams, at column 12 lines 1-9, discloses "the request is received in a manner that does not imply that the request is from a person entitled to receive nonpublic information concerning the first offer". However, Applicant has carefully read the portions of Adams cited by the Examiner and has been unable to locate any disclosure therein concerning communications with persons not known to be entitled to receive nonpublic information.

When Adams speaks at column 12 lines 2-3 of "anonymity among the various subscribers", Adams means that no subscriber knows which other subscriber entered a particular offer or counter-offer into the offer matching system. Adams does not mean that the offer matching system does not know which subscriber entered and is responsible for each offer or counter-offer entered into the offer matching system. As support for this interpretation of Adams's use of the term "anonymity", see Adams at, inter alia:

column 1 lines 26-27 (motivation for Adams's invention included requirement for "... a device which would provide the institutional investors and other traders anonymity and confidentiality when they communicated with each other ..." [emphasis added]);

column 5 lines 65-68 (SIGN ON OR OFF key for use "... whenever the subscriber installation ... is to be unused for an extended period of time or when a different individual becomes the operator of the subscriber installation.");

column 6 lines 35-38 ("Furthermore, security passwords corresponding to each subscriber are also stored in the subscriber file and are accessible by the system and authorized persons at the subscriber installation location");

column 9 lines 53-61 ("In general, a Reply is a direct communication to one or more subscribers. The subscribers involved are always completely anonymous to one another, since the system records internally the senders and receivers of all messages and classifies these senders and receivers by code numbers. A subscriber refers only to a reply number or an offer number printed on a message he receives and the system sends his reply to the originator of the message to which he is replying."); and

column 12 lines 18-20 ("In addition to these reference numbers the system also utilizes an authorized subscriber code which allows the system to identify an authorized user of the system.")

Applicant respectfully requests that the Examiner more particularly identify where Adams discloses a request sent or received in the manner required by claims 169-176.

20 (a-3) Adams fails to disclose in response to such a request, sending a reply that comprises a data item that concerns the offer. In the Office Action at page 4, the Examiner asserts that Adams, at column 10 lines 1-36 and column 12 lines 1-12, discloses "in response to the request, sending a reply comprising a data item that concerns the first offer." However, Applicant has carefully read the portions of Adams cited by the Examiner and has been unable to locate any disclosure therein concerning any sort of response to a request (as distinguished from a counter-offer in response to a prior offer or counter-offer).

30 Applicant respectfully requests that the Examiner more particularly identify where Adams discloses a response to a request and more particularly identify which aspects of Adams's invention the Examiner believes correspond to which aspects of Applicant's invention.

(b) Adams teaches away from the following elements of claims 169-176:

(b-1) Adams teaches away from using a query/response protocol to communicate information about an identified offer. To the contrary, Adams teaches that information about an offer should either be:

broadcast to all or selected subscribers, see for example the detailed description of the "Book and Broadcast" function at column 15 line 69 - column 19 line 72; or

be obtained in response to a "Book Print" command which is not specific to a particular order but rather prints descriptions of all open orders for a particular traded item, see the detailed description of the "Book Print" function at column 13 line 7 - column 15 line 7.

(b-2) Adams teaches away from communicating about offers in a manner that does not imply that such communication is from or to a person entitled to receive nonpublic information about such offer in the following ways:

(b-2-i) Adams teaches that "... the system records internally the senders and receivers of all messages and classifies these senders and receivers by code numbers." See column 9 lines 53-61.

(b-2-ii) Adams teaches the use of "... an authorized subscriber code which allows the system to identify an authorized user of the system." See column 12 lines 18-20.

(b-2-iii) Adams teaches that "... security passwords corresponding to each subscriber are also stored in the subscriber file and are accessible by the system and authorized persons at the subscriber installation location". See column 6 lines 35-38.

(b-2-iv) Adams teaches using the SIGN ON OR OFF key "... whenever the subscriber installation ... is to be unused for an extended period of time or when a different individual becomes the operator of the subscriber installation." See column 5 lines 65-68.

(b-2-v) Adams teaches that communications about offers are made only within the closed community of subscribers, the system, and a bank. Adams does not teach any communication with members of the public about anything.

In light of the foregoing discussion, Applicant respectfully requests that claims 169-176 be allowed.

The **fifth** issue is whether Adams suffices to justify rejection of claim 170.

Claim 170 is dependent upon claim 169. As discussed above, Adams is not sufficient to justify rejection of claim 169. Thus, Adams is not sufficient to justify rejection of dependent claim 170.

In light of the foregoing discussion, Applicant respectfully requests that claim 170 be allowed.

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The **sixth** issue is whether Adams suffices to justify rejection of claim 171 despite: (a) Adams's failure to disclose (a-1) not responding to a request until after an event occurs; and (c) the absence of any statement by the Examiner of the basis for a view as to what constitutes "well known execution information and process of an offer".

Claim 171 is rejected under 35 USC 102(b) for the first time as being anticipated by Adams based upon a bald assertion by the Examiner (without any citation to Adams) that claim 171 "... further recites well known execution information and process of an offer."

(a) Adams fails to disclose elements of claim 171.

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(a-1) Adams fails to disclose not responding to a request until after an event occurs as required by claim 171 element (ii). The Examiner gave no hint as to where the Examiner believes that this element of claim 171 is disclosed in Adams. Applicant has failed to discover in Adams disclosure of not responding to a request until after an event occurs. Applicant respectfully requests that the Examiner identify with specificity where this element of claim 171 is disclosed in Adams.

(c) The Examiner has failed to state any basis for concluding what constitutes "well known execution information and process of an offer." In view of *In Re Alhert and Kruger*, 165 USPQ 418 (CCPA 1970), Applicant respectfully requests that the Examiner provide a statement of the basis, if any, for the Examiner's view.

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In light of the foregoing discussion, Applicant respectfully requests that claim 171 be allowed.

The **seventh** issue is whether Adams suffices to justify rejection of claim 174.

Claim 174 is dependent upon claim 173. As discussed above, Adams is not sufficient to justify rejection of claim 173. Thus, Adams is not sufficient to justify rejection of dependent claim 174.

In light of the foregoing discussion, Applicant respectfully requests that claim 174 be allowed.

The **eighth** issue is whether Adams suffices to justify rejection of claims 179 and  
10 181 despite: (a) Adams's failure to disclose publishing anything; and (b) Adams's teaching away from publishing anything.

Claim 179 is rejected under 35 USC 102(b) for the first time as being anticipated by Adams.

(a) Adams fails to disclose elements of claims 179, including elements which the Examiner asserts Adams does disclose.

(a-1) Adams fails to disclose publishing anything.

In the Office Action at page 4 lines 3-8, in the context of discussing claims 169-176 and 179, the Examiner asserts that Adams discloses several elements that are not contained in claim 179. In case those elements are somehow  
20 relevant to claim 179, please see the fourth issue at (a) for a discussion of the failure of Adams to disclose those elements.

In the Office Action at page 4 lines 20-181, the Examiner asserts that "Adams further teaches publishing the information (col. 12, lines 51-62)." However, Applicant has carefully read the portions of Adams cited by the Examiner and has been unable to locate any disclosure therein concerning publishing any information. Adams at column 12 lines 51-62 discusses sending data that summarizes a days trading transactions to a printer/receiving unit located in a bank to enable the bank to "perform the necessary financial dealings associated with each transaction". Applicant respectfully requests that  
30 the Examiner more specifically identify where Adams discloses "publishing, in a manner that permits receipt and use by members of the public with no right to receive nonpublic



information about the first offer, a data packet that comprises ..." a first offer identifier and a data item about a first offer.

Although the Examiner has not yet asserted that the term "Broadcast" as used in Adams means the same thing as "publish" as used in the Application, Applicant respectfully draws the Examiner's attention to the difference between Adams's definition of "Broadcast" and the normal dictionary meaning of "publish" as used in the Application.

Adams explains at column 2 lines 43-48 that "[i]n connection with this invention the term, provides a "Broadcast" or "broadcasts" an offer, refers to the capability of the present invention by which any subscriber who wishes to make an offer to buy or sell a given security may make this fact known directly to all other subscribers." [Emphasis added.] In the context of Adams, subscribers are known to the system, are assigned passwords and identifiers, and are not unknown members of the public.

The Application does not expressly define "publish". According to Merriam-Webster's Collegiate Dictionary on line (available at <http://www.m-w.com/> as of 2001.10.28), the word "publish", when used in the transitive sense as it is in claims 179 and 181, means: 1a: to make generally known; 1b: to make public announcement of; 2a: to disseminate to the public; 2b: to produce or release for distribution; specifically: PRINT; 2c: to issue the work of (an author).

(b) Adams teaches away from the following elements of claims 179 and 181:

(b-1) Adams teaches away from publishing anything "in a manner that permits receipt and use by members of the public with no right to receive nonpublic information ..." in the following ways:

(b-1-i) Adams teaches that "... the system records internally the senders and receivers of all messages and classifies these senders and receivers by code numbers." See column 9 lines 53-61.

(b-1-ii) Adams teaches the use of "... an authorized subscriber code which allows the system to identify an authorized user of the system." See column 12 lines 18-20.

(b-1-iii) Adams teaches that "... security passwords corresponding to each subscriber are also stored in the subscriber file and are accessible by the system and authorized persons at the subscriber installation location". See column 6 lines 35-38.

(b-1-iv) Adams teaches using the SIGN ON OR OFF key "... whenever the subscriber installation ... is to be unused for an extended period of time or when a different individual becomes the operator of the subscriber installation." See column 5 lines 65-68.

(b-1-v) Adams teaches that communications about offers are made only within the closed community of subscribers, the system, and a bank. Adams does  
10 not teach any communication with members of the public about anything.

In light of the foregoing discussion, Applicant respectfully requests that claims 179, 180 (which depends upon claim 179) and 181 be allowed.

The **ninth** issue is whether Adams suffices to justify rejection of claim 184 despite: (a) Adams's failure to disclose (a-1) storing in the offer matching system an association among a first participant and a first monitor, (a-2) receiving a message from the first monitor that approves a first offer, (a-3) until receiving the message of approval, refusing to execute the first offer against any other offer, and (a-4) after receiving the message of approval, executing the first offer at least in part against a second offer; and  
20 (b) Adams's teaching away from waiting for an approval before executing a first offer against a second offer when the first offer is capable of being executed against the second offer.

Claim 184 is rejected under 35 USC 102(b) for the first time as being anticipated by Adams.

(a) Adams fails to disclose elements of claim 184.

(a-1) Adams fails to disclose storing in the offer matching system an association among a first participant and a first monitor as required by claim 184 step (a). In the Office Action at pages 4-5, the Examiner asserts that "... Adams further teaches the offer matching system monitoring the trade (col. 2, lines 73 - col. 3, lines 1-10).

30 However, Applicant has carefully read the portions of Adams cited by the Examiner and has been unable to locate any disclosure therein concerning storing in the offer matching

system an association among a first participant and a first monitor. Applicant respectfully requests that the Examiner more specifically identify where the Examiner believes this element of claim 184 is disclosed in Adams and specifically which element(s) of Adams's invention the Examiner believes correspond(s) to the first monitor of claim 184.

(a-2) Adams fails to disclose receiving a message from the first monitor that approves a first offer as required by claim 184 step (d). Applicant has carefully read the portions of Adams cited by the Examiner and has been unable to locate any disclosure therein concerning receiving a message from the first monitor that approves a first offer.

10 Applicant respectfully requests that the Examiner more specifically identify where the Examiner believes this element of claim 184 is disclosed in Adams and specifically which element(s) of Adams's invention the Examiner believes correspond(s) to such message of claim 184.

(a-3) Adams fails to disclose refusing to execute the first offer against any other offer until receiving the message of approval as required by claim 184 step (e). Applicant has carefully read the portions of Adams cited by the Examiner and has been unable to locate any disclosure therein concerning refusing to execute an offer until a message of approval is received. Applicant respectfully requests that the Examiner more specifically identify where the Examiner believes this element of claim 184 is disclosed

20 in Adams.

(a-4) Adams fails to disclose executing the first offer at least in part against a second offer after receiving the message of approval, as required by claim 184 step (f). Applicant has carefully read the portions of Adams cited by the Examiner and has been unable to locate any disclosure therein concerning executing an offer after a message of approval is received. Applicant respectfully requests that the Examiner more specifically identify where the Examiner believes this element of claim 184 is disclosed in Adams.

(b) Adams teaches away from the following elements of claim 184:

30 (b-1) Adams teaches away from waiting for an approval before executing a first offer against a second offer when the first offer is capable of being executed against the second offer. To the contrary, Adams teaches that when a first offer

submitted using the "Book" or "Book and Broadcast" function is capable of being executed against a second offer already entered in the applicable book, then the first offer should be immediately executed against the second offer, without waiting for any sort of approval message from anyone. See the detailed description of the "Book" and "Book and Broadcast" function in Adams at column 15 line 69 - column 19 line 72.

The **tenth** issue is whether Adams suffices to justify rejection of claim 180 despite: (c) the absence of any statement by the Examiner of the basis for a view as to what one skilled in the art would do.

10        Claim 180 is rejected under 35 U.S.C. 103(a) for the first time as being unpatentable over Adams.

Claim 180 is dependent upon claim 179. As discussed above, Adams is not sufficient to justify rejection of claim 179. Thus, Adams is not sufficient to justify rejection of dependent claim 179.

(c)     The Examiner has provided no prior art to support the Examiner's contention that it would have been obvious at the time of Applicant's invention for one skilled in the art to modify Adams to include, in combination, all of the following elements of claims 180 and 179 (from which it depends) that are missing from Adams: (a-1) sending or receiving a request that includes an identifier associated with an offer, (a-2) sending or receiving a request in a manner that does not imply that the request is  
20        from a person entitled to receive nonpublic information concerning the offer, (a-3) in response to such a request, sending a reply that comprises a data item that concerns the offer, and (a-4) selecting the data item from the options listed in claim 180. Applicant disagrees with this view, and motivated by the case of *In Re Ahlert and Kruger*, 165 USPQ 418 (CCPA 1970) Applicant hereby challenges this view and asks whether the Examiner can show support for this view

In light of the foregoing discussion, Applicant respectfully requests that claim 180 be allowed.

30        The **eleventh** issue is whether Adams suffices to justify rejection of claims 191, 192, 194, 195, 197-199 and 201-202 despite: (a) Adams's failure to disclose (a-1)

publishing anything; (b) Adams's teaching away from (b-1) publishing anything; and (c) the absence of any statement by the Examiner of the basis for a view as to what one skilled in the art would do.

Claims 191, 192, 194, 195, 197-199 and 201-202 are rejected under 35 U.S.C. 103(a) for the first time as being unpatentable over Adams.

(a) Adams fails to disclose elements of claims 191, 192, 194, 195, 197-199 and 201-202, including elements which the Examiner asserts Adams does disclose.

10 (a-1) Adams fails to disclose publishing anything. In the Office Action at the bottom of page 5 the Examiner asserts that Adams discloses "... publishing a first data packet that comprises the first identifier and a first data item, the first data item concerning the first offer (col. 12, lines 51-62). However, Applicant has carefully read the portions of Adams cited by the Examiner and has been unable to locate any disclosure therein concerning publishing any information. Please see the more extensive discussion of this point that is set forth above for the eighth issue at (a-1).

(b) Adams teaches away from the following elements of claims 191, 192, 194, 195, 197-199 and 201-202:

(b-1) Adams teaches away from publishing anything. Please see the more extensive discussion of this point that is set forth above for the eighth issue at (b-1).

20 (c) The Examiner has provided no prior art to support the Examiner's contention that it would have been obvious at the time of Applicant's invention for one skilled in the art to modify Adams to include, in combination, all of the elements of claims 191, 192, 194, 195, 197-199 and 201-202 that are missing from Adams, including, inter alia: (a-1) publishing a first data packet that comprises the first identifier and a first data item, the first data item concerning either the first offer or an execution of the first offer. Applicant disagrees with this view, and motivated by the case of *In Re Ahlert and Kruger*, 165 USPQ 418 (CCPA 1970) Applicant hereby challenges this view and asks whether the Examiner can show support for this view

In light of the foregoing discussion, Applicant respectfully requests that claims 191, 192, 194, 195, 197-199 and 201-202 be allowed.

The **twelfth** issue is whether Adams suffices to justify rejection of claim 193 despite: (a) Adams's failure to disclose (a-1) publishing anything; (a-2) publishing a data packet that comprises a first identifier and a first data item that concerns a first offer, (a-3) a predetermined relationship between the first data item and a second offer; (b) Adams's teaching away from (b-1) publishing anything; and (c) the absence of any statement by the Examiner of the basis for a view as to what one skilled in the art would do.

Claim 193 is rejected under 35 U.S.C. 103(a) for the first time as being unpatentable over Adams.

10           (a)     Adams fails to disclose elements of claim 193, including elements which the Examiner asserts Adams does disclose.

              (a-1)   Adams fails to disclose publishing anything. In the Office Action at the bottom of page 5 the Examiner asserts that Adams discloses "... publishing a first data packet that comprises the first identifier and a first data item, the first data item concerning the first offer (col. 12, lines 51-62)." However, Applicant has carefully read the portions of Adams cited by the Examiner and has been unable to locate any disclosure therein concerning publishing any information. Please see the more extensive discussion of this point that is set forth above for the eighth issue at (a-1).

              (a-2)   Adams fails to disclose publishing a data packet that comprises a  
20   first identifier and a first data item that concerns the first offer. Applicant has carefully read the portions of Adams cited by the Examiner and has been unable to locate any disclosure therein concerning publishing any data packet. Applicant respectfully requests that the Examiner more particularly identify which elements of Adams disclosure correspond to this element of claim 191 upon which claim 193 depends.

              (a-3)   Adams fails to disclose a predetermined relationship between the first data item and a second offer. Applicant has carefully read the portions of Adams cited by the Examiner and has been unable to locate any disclosure therein concerning such a predetermined relationship. Applicant respectfully requests that the Examiner more particularly identify which elements of Adams disclosure correspond to this  
30   element of claim 193.

              (b)     Adams teaches away from the following elements of claim 193:

(b-1) Adams teaches away from publishing anything. Please see the more extensive discussion of this point that is set forth above for the eighth issue at (b-1).

(c) The Examiner has provided no prior art to support the Examiner's contention that it would have been obvious at the time of Applicant's invention for one skilled in the art to modify Adams to include, in combination, all of the elements of claim 193 that are missing from Adams, including, inter alia: (a-1) publishing anything; (a-2) publishing a data packet that comprises a first identifier and a first data item that concerns the first offer, and (a-3) a predetermined relationship between the first data item and a second offer. Applicant disagrees with this view, and motivated by the case of *In Re Ahlert and Kruger*, 165 USPQ 418 (CCPA 1970) Applicant hereby challenges this view and asks whether the Examiner can show support for this view

In light of the foregoing discussion, Applicant respectfully requests that claim 193 be allowed.

The **thirteenth** issue is whether Adams suffices to justify rejection of claim 200 despite: (a) Adams's failure to disclose (a-1) publishing anything; (a-2) publishing a data packet that comprises a first identifier and a first data item that concerns an execution of the first offer, (a-3) a predetermined relationship between the first data item and the first offer; (b) Adams's teaching away from (b-1) publishing anything; and (c) the absence of any statement by the Examiner of the basis for a view as to what one skilled in the art would do.

Claim 200 is rejected under 35 U.S.C. 103(a) for the first time as being unpatentable over Adams.

(a) Adams fails to disclose elements of claim 200, including elements which the Examiner asserts Adams does disclose.

(a-1) Adams fails to disclose publishing anything. In the Office Action at the bottom of page 5 the Examiner asserts that Adams discloses "... publishing a first data packet that comprises the first identifier and a first data item, the first data item concerning the first offer (col. 12, lines 51-62)." However, Applicant has carefully read the portions of Adams cited by the Examiner and has been unable to locate any disclosure

therein concerning publishing any information. Please see the more extensive discussion of this point that is set forth above for the eighth issue at (a-1).

(a-2) Adams fails to disclose publishing a data packet that comprises a first identifier and a first data item that concerns an execution of the first offer against the second offer. Applicant has carefully read the portions of Adams cited by the Examiner and has been unable to locate any disclosure therein concerning publishing any data packet. Applicant respectfully requests that the Examiner more particularly identify which elements of Adams correspond to this element of claim 197 upon which claim 200 depends.

10 (a-3) Adams fails to disclose a predetermined relationship between the first data item and the first offer. Applicant has carefully read the portions of Adams cited by the Examiner and has been unable to locate any disclosure therein concerning such a predetermined relationship. Applicant respectfully requests that the Examiner more particularly identify which elements of Adams disclosure correspond to this element of claim 200.

(b) Adams teaches away from the following elements of claim 200:

(b-1) Adams teaches away from publishing anything. Please see the more extensive discussion of this point that is set forth above for the eighth issue at (b-1).

(c) The Examiner has provided no prior art to support the Examiner's  
20 contention that it would have been obvious at the time of Applicant's invention for one skilled in the art to modify Adams to include, in combination, all of the elements of claim 200 that are missing from Adams, including, inter alia: (a-1) publishing anything; (a-2) publishing a data packet that comprises a first identifier and a first data item that concerns an execution of the first offer, and (a-3) a predetermined relationship between the first data item and the first offer. Applicant disagrees with this view, and motivated by the case of *In Re Ahlert and Kruger*, 165 USPQ 418 (CCPA 1970) Applicant hereby challenges this view and asks whether the Examiner can show support for this view

In light of the foregoing discussion, Applicant respectfully requests that claim 200 be allowed.

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The **fourteenth** issue is whether Adams suffices to justify rejection of claim 203 despite: (a) Adams's failure to disclose (a-1) storing in the offer matching system an association among a first participant and a first monitor, (a-2) receiving a message that approves a first offer, (a-3) determining that the message is from the first monitor, (a-4) before determining that the message is from the first monitor, refusing to execute the first offer against any other offer, and (a-5) after determining that the message is from the first monitor, executing the first offer at least in part against a second offer; (b) Adams's teaching away from waiting for an approval before executing a first offer against a second offer when the first offer is capable of being executed against the second offer; and (c) the absence of any statement by the Examiner of the basis for a view as to what one skilled in the art would do.

Claim 203 is rejected under 35 USC 103(a) for the first time as being unpatentable over Adams.

(a) Adams fails to disclose elements of claim 203.

(a-1) Adams fails to disclose storing in the offer matching system an association among a first participant and a first monitor as required by claim 203 step (a). In the Office Action at page 7, the Examiner asserts that "... Adams further teaches storing in the offer matching system a first association among a first participant and a first monitor (col. 2, lines 73-, col. 3, lines 1-10)." However, Applicant has carefully read the portions of Adams cited by the Examiner and has been unable to locate any disclosure therein concerning storing in the offer matching system an association among a first participant and a first monitor. Applicant respectfully requests that the Examiner more specifically identify where the Examiner believes this element of claim 203 is disclosed in Adams and specifically which element(s) of Adams's invention the Examiner believes correspond(s) to the first monitor of claim 203.

(a-2) Adams fails to disclose receiving a message that approves a first offer, as required by claim 203 step (e). Applicant has carefully read the portions of Adams cited by the Examiner and has been unable to locate any disclosure therein concerning receiving a message from anyone that approves a first offer. Applicant respectfully requests that the Examiner more specifically identify where the Examiner believes this element of claim 203 is disclosed in Adams and specifically which

element(s) of Adams's invention the Examiner believes correspond(s) to such message of claim 203.

(a-4) Adams fails to disclose determining that the message is from the first monitor, as required by claim 203 step (f). Applicant has carefully read the portions of Adams cited by the Examiner and has been unable to locate any disclosure therein concerning making such a determination. Applicant respectfully requests that the Examiner more specifically identify where the Examiner believes this element of claim 203 is disclosed in Adams.

10 (a-5) Adams fails to disclose refusing to execute the first offer against any other offer until determining that the message is from the first monitor, as required by claim 203 step (g). Applicant has carefully read the portions of Adams cited by the Examiner and has been unable to locate any disclosure therein concerning refusing to execute an offer until making such a determination. Applicant respectfully requests that the Examiner more specifically identify where the Examiner believes this element of claim 203 is disclosed in Adams.

(a-5) Adams fails to disclose executing the first offer at least in part against a second offer after determining that the message is from the first monitor, as required by claim 203 step (h). Applicant has carefully read the portions of Adams cited by the Examiner and has been unable to locate any disclosure therein concerning  
20 executing an offer making such a determination. Applicant respectfully requests that the Examiner more specifically identify where the Examiner believes this element of claim 203 is disclosed in Adams.

(b) Adams teaches away from the following elements of claim 203:

(b-1) Adams teaches away from waiting for an approval before executing a first offer against a second offer when the first offer is capable of being executed against the second offer. To the contrary, Adams teaches that when a first offer submitted using the "Book" or "Book and Broadcast" function is capable of being executed against a second offer already entered in the applicable book, then the first offer should be immediately executed against the second offer, without waiting for any sort of  
30 approval message from anyone. See the detailed description of the "Book" and "Book and Broadcast" function in Adams at column 15 line 69 - column 19 line 72.

(c) The Examiner has provided no prior art to support the Examiner's contention that it would have been obvious at the time of Applicant's invention for one skilled in the art to modify Adams to include, in combination, all of the elements of claim 203 that are missing from Adams, including, inter alia: (a-1) storing in the offer matching system an association among a first participant and a first monitor, (a-2) receiving a message that approves a first offer, (a-3) determining that the message is from the first monitor, (a-4) before determining that the message is from the first monitor, refusing to execute the first offer against any other offer, and (a-5) after determining that the message is from the first monitor, executing the first offer at least in part against a second offer. Applicant disagrees with this view, and motivated by the case of *In Re Ahlert and Kruger*, 165 USPQ 418 (CCPA 1970) Applicant hereby challenges this view and asks whether the Examiner can show support for this view.

In light of the foregoing discussion, Applicant respectfully requests that claim 203 be allowed.

The **fifteenth** issue is whether Adams in view of Hauser et al. (WO 97/25801 hereinafter Hauser) suffices to justify rejection of claims 177-178 despite: (a) Adams's failure to disclose (a-1) receiving a request that includes a first identifier associated with a first offer, (a-2) in response to such request, sending a reply that comprises a data item that concerns the first offer, (a-3) in response to such request, sending a reply that comprises a digital signature, and (a-4) sending the response in a manner that is secured without relying upon the digital signature; (b) Adams's teaching away from (b-1) using a query/response protocol to communicate information about a particular offer; and (c) the absence of any statement by the Examiner of the basis for a view as to what one skilled in the art would do.

Claims 177-178 are rejected under 35 U.S.C. 103(a) for the first time as being unpatentable over Adams in view of Hauser.

(a-1) Adams fails to disclose receiving a request that includes a first identifier associated with a first offer. In the Office Action at page 4, the Examiner asserts that Adams, at column 10 lines 1-15 and column 12 lines 1-9, teaches "receiving request for information where the request includes the first identifier". However,

Applicant has carefully read the portions of Adams cited by the Examiner and has been unable to locate any disclosure therein concerning a request that includes an identifier associated with an offer.

In reviewing the portions of Adams cited by the Examiner, it is important to note that when Adams speaks of a "Reply", he is speaking of a counter-offer that is entered into an offer matching system by a subscriber to that system. Adams is not speaking of a reply by an offer matching system to a request for information that includes an identifier associated with an offer. Consequently, Adams's specialized use of the term "Reply" should not be understood to imply any sort of underlying request to an offer matching system.

Please see the more extensive discussion of this point above at the fourth issue (a-1).

(a-2) Adams fails to disclose in response to such a request, sending a reply that comprises a data item that concerns the first offer. In the Office Action at page 4, the Examiner asserts that Adams, at column 10 lines 1-36 and column 12 lines 1-12, discloses "in response to the request, sending a reply comprising a data item that concerns the first offer." However, Applicant has carefully read the portions of Adams cited by the Examiner and has been unable to locate any disclosure therein concerning any sort of response to a request (as distinguished from a counter-offer in response to a prior offer or counter-offer).

Applicant respectfully requests that the Examiner more particularly identify where Adams discloses a response to a request and more particularly identify which aspect of Adams's invention the Examiner believes correspond to which aspects of Applicant's invention.

(a-3) Adams fails to disclose in response to such request, sending a reply that comprises a digital signature. The Examiner admits this failure by relying upon Hauser in making this rejection.

(a-4) Adams fails to disclose sending the response in a manner that is secured without relying upon the digital signature. The Examiner has cited noting in Adams or Hauser that discloses this requirement of claim 177 step (c)(2) or claim 178

element (c)(2). Applicant respectfully requests that the Examiner identify where Adams or Hauser discloses this element.

(b) Adams teaches away from the following elements of claims 177-178:

(b-1) Adams teaches away from using a query/response protocol to communicate information about an identified offer. To the contrary, Adams teaches that information about an offer should either be:

broadcast to all or selected subscribers, see for example the detailed description of the "Book and Broadcast" function at column 15 line 69 - column 19 line 72; or

10 be obtained in response to a "Book Print" command which is not specific to a particular order but rather prints descriptions of all open orders for a particular traded item, see the detailed description of the "Book Print" function at column 13 line 7 - column 15 line 7.

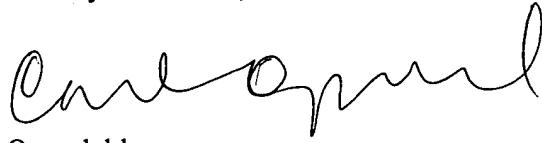
(c) The Examiner has provided no prior art to support the Examiner's contention that it would have been obvious at the time of Applicant's invention for one skilled in the art to modify Adams to include, in combination, all of the elements of claims 177-178 that are missing from Adams, including, inter alia: (a-1) receiving a request that includes a first identifier associated with a first offer, (a-2) in response to such request, sending a reply that comprises a data item that concerns the first offer, (a-3) 20 in response to such request, sending a reply that comprises a digital signature, and (a-4) sending the response in a manner that is secured without relying upon the digital signature. Applicant disagrees with this view, and motivated by the case of *In Re Ahlert and Kruger*, 165 USPQ 418 (CCPA 1970) Applicant hereby challenges this view and asks whether the Examiner can show support for this view.

In light of the foregoing discussion, Applicant respectfully requests that claims 177-178 be allowed.

### Conclusion

30 For the reasons discussed above, Applicant respectfully requests that claims 169-208 be allowed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Carl Oppedahl". The signature is fluid and cursive, with the first name "Carl" being more distinct than the last name "Oppedahl".

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